

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** JOSEPH H. McCAIN, E. R. WEBB and WILLIAM R. LUEDERS

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Appeal No. 1998-3080  
Application 08/298,540

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HEARD: February 6, 2001

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Before HAIRSTON, FLEMING and BARRY, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 21 through 23, 25 through 30, 32, 33 and 38. Claims 1 through 20 have been canceled. Claims 24 and 34 through 37 have been indicated as being allowable by the Examiner. Claim 31 has been objected to for being dependent upon a rejected

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claim. Thus, claims 21 through 23, 25 through 30, 32, 33 and 38 are before us for our consideration of this appeal.

The invention is directed to a computer communication system for providing data interchange between a host computer and a handheld portable computer.

Independent claim 21 is reproduced as follows:

21. A data and communications system for providing interchange of data comprising, a host computer for processing data, a self-contained handheld portable computer adapted to execute a program and for communication with said host computer, a communications link for data transfer and control between said host computer and said self-contained handheld portable computer, a factory controller to control a factory environment, and a network of interface units to couple said self-contained handheld portable computer with said factory controller, wherein said self-contained handheld portable computer includes a display device having a display operable to display split screen operation of simultaneous text and graphic information.

The Examiner relies on the following references:

Lockhart, Jr. et al (Lockhart)            4,247,908            Jan. 27,  
1981

Gfeller, F. R. et al, "Infrared Communications For In-House Applications", IBM Zurich Research Laboratory, IEEE publications, 1976, pp. 132-138.

Robinson, Barbara, "The HP 150", Byte, October 1983, pp. 36-50.

Claims 21 through 23, 25 through 30, 32 and 33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lockhart, Gfeller and Robinson. Claim 38 stands rejected under 35 U.S.C. § 103 as being unpatentable over Lockhart and Gfeller.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the briefs<sup>1</sup> and answer for the details thereof.

#### **OPINION**

After a careful review of the evidence before us, we agree with the Examiner that claims 21 through 23, 25 through 30, 32, 33 and 38 are properly rejected under 35 U.S.C. § 103.

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<sup>1</sup>Appellants filed an appeal brief on May 23, 1996. The Examiner mailed a letter of noncompliance on July 1, 1997. In response, Appellants filed a substitute appeal brief on August 5, 1997. We will thereby refer to this substitute of appeal brief as the brief throughout the opinion. Appellants filed a reply brief on January 26, 1998. The Examiner mailed an Office communication on April 29, 1998 stating that the reply brief has been entered and considered.

In regard to the rejection of claims 21 through 23, 25 through 30, 32 and 33, we note that Appellants state on page 5 of the brief that the claims 21, 25, 26, 29 and 32 do not stand or fall together. We find no statement in regard to claims 22, 23, 27, 28, 30 and 33 on appeal. We note that Appellants argue all of the claims as a single group in the brief. We note that on pages 9 through 11 that the Appellants state what claims 22, 23, 25, 26, 27, 30, 32 and 33 recite but make no argument as to why the Examiner's rejection is improper. 37 CFR § 1.192 (c)(7) (July 1, 1996) **as amended at** 60 Fed. Reg. 14518 (March 17, 1995), which was controlling at the time of Appellants' filing the brief, states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground to rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider the Appellants' claims as standing

or falling together and we will treat claim 21 as a representative claim of that group.

On page 6 of the brief, Appellants argue that Lockhart does not disclose the split screen operation of the presently claimed invention. Appellants further argue that Lockhart does not disclose the miniaturization sufficient for split screen operation. Appellants argue that Lockhart discloses a data transfer rate of 1,200 bits per second which is too slow to support the split screen operation.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the

claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Our reviewing court stated in *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. . 1989) that "claims must be interpreted as broadly as their terms reasonably allow."

We note that Appellants' claim 21 recites "said self-contained handheld portable computer includes a display device

having a display operable to display split screen operation of simultaneous text and graphic information." We note that the terms simultaneous text and graphic information are broad terms and do not require a particular amount of data. For instance, the graphical information could be a simple logo which would not require many bits of data. Similarly, text could be one or two letters. Thus, the data transfer rate that the Appellants are arguing is not required by the Appellants' claim 21. Furthermore, the claim does not require any particular miniaturization, only that the display is operable to display a split screen operation of simultaneous text and graphical information. Thus, we do not find that Lockhart's teachings would teach away from the use of the Robinson's concept of displaying text and graphics simultaneously on the screen of the Lockhart display.

Appellants argue that Gfeller does not disclose the self-contained handheld personal computer including the display device having a display operable to display split screen operation of simultaneous text and graphical information as required by Appellants' claim 21. See pages 6 and 7 of the

brief.

The Examiner does not rely on Gfeller for the teachings of a self-contained handheld computer or the concept of operating the display to display simultaneous text and graphic information. The Examiner relies on Lockhart for the teaching of a self-contained handheld portable computer and Robinson for the concept of displaying simultaneous text and graphical information. See pages 4 and 5 of the answer.

Appellants argue that Robinson does not disclose or suggest including a self-contained handheld computer including the display device having a display operation to display the split screen operation of simultaneous text and graphical information as required by Appellants' claim 21. Appellants argue that the Robinson's teaching of a split screen feature is not a handheld device and not a personal computer. Appellants argue that to achieve the split screen operation in a handheld device requires a degree of miniaturization of necessary components in order to achieve the desired results.

The test of obviousness is not whether features of a

secondary reference may be bodily incorporated into the primary reference's structure, nor whether the claimed invention is expressly suggested in any one or all of the references; rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. **See In re Keller**, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). It is further established that "[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." **Pro-Mold & Tool Co. V. Great Lakes Plastics, Inc.**, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), **citing In re Rinehart**, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in **Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.**, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had



before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants.

We noted that the Examiner is not relying on Robinson's hardware, the Hewlett Packard personal computer, but instead is relying on the teaching of the concept of displaying both graphics and text simultaneously on screen. On page 39, Robinson teaches how to increase performance of a display by using a split screen to display both graphics and text simultaneously. From these teachings by Robinson, we find that one of ordinary skill in the art would have reasons to use these teachings to display a simple graphics and text message simultaneously on the Lockhart handheld device.

In the reply brief, Appellants argue that the Robinson's Hewlett Packard personal computer cannot read on a portable handheld computer as claimed. We do not find that we need to reach this issue since the Examiner has relied on Lockhart for the teachings of a portable handheld computer.

In regard to the rejection of claim 38, Appellants argue that Lockhart does not disclose or suggest a self-contained

portable computer to execute an independent program independently input from a source other than a communication system. On page 9 of the answer, the Examiner responds that Lockhart teaches a keyboard input 114, a portable terminal 14, which allows an operator to enter, modify, or erase data which reads on Appellants' claimed limitation.

Upon our review of Lockhart, we find that in column 9, lines 46 through 48, Lockhart teaches that keyboard 114 allows the user to enter, modify, or erase input data as desired. We find that the claim language "a self-contained portable computer to execute an independent program independently input from a source other than a computer communication system" as recited in claim 38 would read on the software which allows the entry, modification and erasing of input data of the Lockhart system.

In view of the foregoing, the decision of the Examiner rejecting claims 21 through 23, 25 through 30, 32, 33 and 38 under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

**AFFIRMED**

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
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	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	APPEALS AND
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	)	INTERFERENCES
	)	
LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	

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